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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

28787.70 (SS00301)

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Application Number

10/689,370

Filed

October 20, 2003

First Named Inventor

Chen et al.

Art Unit

2863

Examiner

Sun, Xiugin

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

 applicant/inventor. assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96) attorney or agent of record.
Registration number _____ attorney or agent acting under 37 CFR 1.34.Registration number if acting under 37 CFR 1.34 37,713

Signature

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Typed or printed name

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Telephone number

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

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Response Under 37 CFR § 1.116
Expedited Procedure – Group Art Unit 2855
Appl. No. 10/689,370
Reasons in Support of Pre-Appeal Brief Request for Review



Patent/Docket No. 28787.70 (SS00301)
Customer No. 000027683

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:
Chuxin CHEN et al. § Confirmation No. 2855

Serial No.: 10/689,370 § Group Art Unit: 2863

Filed: October 20, 2003 § Examiner: Sun, Xiugin

For: Rule Based Capacity Management
System for an Inter-Office Facility §

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REASONS IN SUPPORT OF PRE-APPEAL BRIEF REQUEST FOR REVIEW

I. **BACKGROUND**

The present paper is being filed under the Official Gazette Notice of July 12, 2005 and in response to the final Office action mailed May 17, 2006, and the Advisory Action mailed July 20, 2006.

A Notice of Appeal and Request for One Month Extension of time, each with the proper fee, are being filed concurrently with this paper. It is assumed that no additional fees are required, but if any additional fees are required, the Commissioner is hereby authorized to charge any fees, including those for an extension of time, to Haynes and Boone, LLP's Deposit Account No. 08-1394.

II. REASONS

In the final Office action mailed May 17, 2006, claims 1-20 were pending and under consideration. Claims 1-20 were rejected.

Independent claim 1 stands rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,999,179 to Kekic et al. (“Kekic”) in view of U.S. Patent No. 5,210,704 to Husseiny (“Husseiny”). Independent claim 5 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kekic in view of Husseiny and U.S. Patent No. 5,761,432 to Bergholm et al. (“Bergholm”). Independent claim 10 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Kekic in view of Husseiny and U.S. Patent No. 5,678,042 to Pisello et al. (“Pisello”). It is respectfully submitted that there are clear errors with the Examiner's rejection of the claims. More specifically, and as described below, the grounds for rejection are clearly legally deficient because the asserted prior art lacks essential elements needed to establish a *prima facie* rejection with respect to each claim.

In particular, MPEP §2142 specifies that:

The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. . . . To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art references must teach or suggest all the claim limitations.

As further explained in MPEP §2142:

To reach a proper determination under 35 U.S.C. 103, the examiner must step backward in time and into the shoes worn by the hypothetical "person of ordinary skill in the art" when the invention was unknown and just before it was made. In view of all factual information, the examiner must then make a determination whether the claimed invention "as a whole" would have been obvious at that time to that person.

Accordingly, it is incumbent upon the Examiner in the first instance to factually support a conclusion of obviousness of the claims as a whole.

A. **Claim 1**

There are clear errors in the rejection of claim 1 under 35 U.S.C. §103(a) because there are limitations in claim 1 that are not rendered obvious by the combination of Kekic and Husseiny. In particular, the limitation of:

a program for creating one or more analytical reports about the monitor set based on the rules and the data, wherein the one or more analytical reports include a prediction of exhaustion of the equipment, wherein the program includes:

an inference engine having instructions for . . . firing the rule on the data to produce an analysis and to create the one or more analytical reports

is neither taught nor suggested by the combination of Kekic and Husseiny. In particular, in the “Response to Arguments” set forth on page 20 *et seq.* of the final Office action, the Examiner posits that, giving the claim its broadest reasonable interpretation, the Kekic reference teaches this limitation. Applicants respectfully disagree.

As defined by Merriam-Webster’s Online Dictionary, a “report” is “a usually detailed account or statement.” This definition is entirely consistent with Applicants’ use of the term “report” throughout the application.

As the foregoing clearly indicates, the “logging of pertinent information” or provision of “visual clues” in Kekic does not rise to the level of an “analytical report” as that phrase is used throughout the specification and within claim 1. Husseiny fails to remedy the deficiencies of Kekic in this regard.

Additionally, Applicants maintain their position that Husseiny, which is cited by the Examiner as teaching “an analytical report which includes a prediction of exhaustion of the equipment,” fails to do so for the reasons set forth in the Amendment filed March 10, 2006. Applicants submit that the Examiner’s response to this argument do not establish Husseiny’s teaching of the concept of an analytical report that includes a prediction of equipment failure as asserted by the Examiner. In view of this and the fact that Husseiny fails to remedy the deficiencies of Kekic, as described above, it is apparent that, even when combined, the references do not teach the subject matter as claimed in independent claim 1; therefore, the subject rejection thereof should be withdrawn.

Therefore, the Examiner has failed to carry the burden of establishing a *prima facie* case of obviousness with respect to claim 1, as well as claims 2, 3, and 13-15, each of which depends directly or indirectly from claim 1.

B. Claim 4

There are clear errors in the rejection of claim 4 under 35 U.S.C. §103(a) because there are limitations in claim 4 that are not rendered obvious by the combination of Kekic, Husseiny, and Bergholm. In particular, the limitations of:

defining a review for the selected configuration, the review identifying one or more rules usable to calculate exhaustion of the equipment

and

receiving a comparison of the data and the review

are neither taught nor suggested by the cited combination of references

In particular, at most the sections of Kekic cited by the Examiner disclose defining general rules to be applied by the system upon the occurrence of certain conditions. Applicants submit that this is not equivalent to defining a review for a selected configuration, wherein the review identifies one or more rules. While a “review” identifies one or more rules, a “review for a selected configuration” identifies, in addition to one or more rules, one or more pieces of equipment and various parameters for the equipment. In contrast, Kekic does not disclose defining a “review”; rather, it merely discloses defining a plurality of rules.

Husseiny, which is cited by the Examiner as teaching a rule-based monitoring expert system including at least one rule usable to calculate exhaustion of the equipment, and Bergholm, which is cited by the Examiner as teaching step of and means for obtaining equipment related data using a separate inventory system, fail to remedy the deficiencies of Kekic in this regard for the reasons previously set forth.

Therefore, the Examiner has failed to carry the burden of establishing a *prima facie* case of obviousness with respect to claim 4, as well as claims 5-9, each of which depends directly or indirectly from claim 4.

C. Claim 10

There are clear errors in the rejection of claim 10 under 35 U.S.C. §103(a) because there are limitations in claim 10 that are not rendered obvious by the combination of Kekic, Husseiny, and Pisello. In particular, the limitation of:

a program for creating one or more analytical reports about the monitor set based on the rules and the data, wherein at least one of the analytical reports details a relationship between demand and capacity for at least a portion of the equipment

is neither taught nor suggested by the cited combination of references. Applicants respectfully traverse

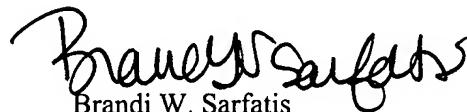
the Examiner's position that Kekic teaches a program for creating one or more analytical reports for the reasons set forth in detail above with respect to claim 1. Husseiny, which is cited by the Examiner as teaching a rule-based monitoring expert system, wherein at least one rule enables a prediction of equipment exhaustion, and Pisello, which is cited by the Examiner as teaching a program for creating one or more analytical reports about a monitor set, wherein at least one of the analytical reports details a relationship between demand and capacity for at least a portion of the equipment, fail to remedy the deficiencies of Kekic in this regard.

Therefore, the Examiner has failed to carry the burden of establishing a *prima facie* case of obviousness with respect to claim 10, as well as claims 11, 12, and 16-20, each of which depends directly or indirectly from claim 10.

III. CONCLUSION

Applicants have therefore demonstrated three clear legal deficiencies in the Examiner's position. Consequently, the rejections are clearly not proper and are without basis and it is therefore respectfully requested that the rejections be withdrawn.

Respectfully submitted,


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